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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/977,644      11/24/97      EMERSON

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HM12/0723

EXAMINER
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LEVY, N

ART UNIT	PAPER NUMBER
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1616

DATE MAILED:

07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

Examiner

Applicant(s)

Group Art Unit

08 997644

E. M. ERSON et al

M. C. M. C. M.

166

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/26/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 14, 16 and 18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 14, 16 and 18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1616

Receipt is acknowledged of T.D. (3/16/01) and Amendment (4/26/01).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Newly submitted claim 7 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: this claim incorporated encapsulated forms, never before claimed, and not examined. This is an independent invention, patentably distinct from the invention otherwise claimed. This material should be deleted in this application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 7 is, too the encapsulated aspect withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment of 3/16/01 has been entered as "new rules" did not extend to reissues.

Claims 1, 2, 5-8, 12-14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained re the formula as opposed to treated compounds, as supported by the C.I.P. of this specification as patent # 5676958.

Application than referred to pages, removed from consideration, in favor of the art up copy of the patent as submitted as the second substitute specification of 11/01/99. Please direct the remarks

Art Unit: 1616

and support to appropriate column and line of the cut up submission of 11/01/99, for consideration--this copy is the marked up only in red.

Claims 1-6, 16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained.

Again, applicant refers to both a 5676958 and '968 patent C.I.P.'s of the instant application, thus providing support; we fail to find support in this specification under consideration, for the housing limitations, the high and low level concentrations and the general formula.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 54, 56-62 of copending Application No. 08/479,623. Although the conflicting claims are not identical, they are not patentably distinct

Art Unit: 1616

from each other because the instant claims are obvious over the application of methods of 07/479623, since the same compounds are applied at the same rate with the same effect.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 25, 29-39, 41, 57, 61, 66-69, 71-75, 77-86 of copending Application No. 08/860514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '860 encompasses the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 14-16, 29-33 of copending Application No. 08/860499. Although the conflicting claims are not identical, they are not patentably distinct from each other because 08/860499 encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 7-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8, 10, 14-23, 39 of copending Application No. 08/336973. Although the conflicting claims are not identical, they are

Art Unit: 1616

not patentably distinct from each other because 08/336973 encompasses the instant invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-10, 12-14, 16, 17, 19-22 of copending Application No. 09/431542. Although the conflicting claims are not identical, they are not patentably distinct from each other because 09/431542 encompasses the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 5676958. This is a double patenting rejection.

Claims ~~7, 12, 14~~ and 16, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Howell et al 5102675.

The rejection of record is maintained.

Various aromatic aldehydes, inclusive of coniferaldehyde (col. 2, lines 11-13) are in the oak--they have to be extracted, thus they must be coupled or bound to the wood--cellulose, absent any showing by applicant that coniferaldehyde is NOT coupled to the solid (oak) support. The coupling is indicated at col. 3, lines 30-40. Further, the ethanol and wine components of the

Art Unit: 1616

barrels constitute possible insect ingress--egress and attractant aspects, of the instant invention as claimed.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong 5149715.

The rejection of record is maintained.

There is no limitations or concentrations on the instant claim to distinguish from the references and the claimed limitations of 70% kill are within those of shown effective in the instant specification of the concentration of Armstrong.

Claims 1, 3, 5, 7, 12, 14, <sup>16</sup>and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Metcalf et al. '89.

The rejection of record is maintained.

Applicant provides no enabling distinction for the coupling to a solid support over that provided by Metcalf; there is no distinction determinable.

Claims 1-7, 12-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando--JP 266809.

The rejection of record is maintained.

The claimed limitations of the cinnamic aldehyde cellulose-bound composition is met--and it's in a house permitting cockroach egress/ingress. No patentable weight is given to future intended use.

Art Unit: 1616

Claims 1-5, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Saotome--FR 2529755.

The rejection of record is maintained.

Thrips and nematodes are controlled, they're insects.

Claims 1-4, 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorman et al -2465854.

For insects and arachnids killed, Dorman states "besides the control of house flies--cinnamic aldehyde-for eradicating insects, e.g. aphids, diabrotica, red spiders, thrips etc.--"at col. 3, bottom--carriers are fenchyl and bornyl alcohols, glycol ethers and alcohols, and as (col. 3) wood flour, clay, talc, bentonite or as dusting powders (col. 2) none of which are outside of the instantly claimed limitations. Again, the combining with wood flour constitutes the same degree of enablement of the instant claimed coupled cellulosic binding domain support.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Berke et al 4525480.

Cinnamaldehyde, 4 to 1 with paraben preservatives (col. 1, line 17-19, 59-64) at the concentration shown by applicant to kill 70% of target population is used as a detergent (shampoo) composition at claim 8. This is the instant composition as claimed.

Applicant's arguments filed 3/16/01 have been fully considered but they are not persuasive. Applicants arguments, where persuasive, have resulted in withdrawal of rejections. New rejections have been instituted in response to amendment. Applicant's arguments have been



Art Unit: 1616

considered, and addressed in accord with maintaining rejections of record, and in consideration of amendments.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308\*2412. The examiner can normally be reached on Tuesday-Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv

July 18, 2001



NEIL S. LEVY  
PRIMARY EXAMINER